

The undersigned attorney has confirmed with inventor Paul J. Hindrichs that the inventors of the subject matter claimed in this application are Alex A. Peterson, Paul J. Hindrichs, Mark D. Wahlberg, Todd A. Berg, and Jon P. St. Germain. These are the inventors named on the present application, on the original priority application (now U.S. patent 6,152,937), and on the intervening priority application (now U.S. patent 6,673,084). There has never been any change in the inventorship in this chain of filings, and this inventorship remains correct for the present application.

II. The Rejections Based on 35 U.S.C. § 102

Claims 83-85 and 87-90 have been rejected under 35 U.S.C. § 102 as anticipated by Kaster et al. U.S. patent 5,234,447 ("Kaster"). This rejection is respectfully traversed.

Claim 83 specifies, inter alia, "a structure which is annularly continuous" Kaster does not show such a structure. Kaster's structure is made from an initially flat sheet (see FIGS. 8 and 9 of Kaster). This initially flat sheet is bent into a shape that is more nearly circular (see FIG. 9 of Kaster). But there is no indication in Kaster that the ends of this nearly circular shape are actually joined to one another to produce an annularly continuous structure, as

specified by applicants in claim 83. Thus FIG. 10 of Kaster shows the ends of connecting unit 46 close to one another. But it does not show those ends actually touching one another, much less secured to one another to form an annularly continuous structure.

Applicants acknowledge that Kaster column 5, lines 59-61 state "Each of these members (43) and (44) are operably joined in this embodiment through use of a connecting unit (46) comprising a band." But applicants do not believe that this use of the word "band" constitutes a teaching that element 46 becomes annularly continuous. Element 46 is clearly shown as only C-shaped in FIG. 10 of Kaster, and applicants do not believe that Kaster's use of the word "band" is either necessarily inconsistent with that depiction or sufficient to convert that depiction to something other than what it is, namely, a depiction of a C with an opening at one point which is characteristic of a C shape.

In addition to the above distinction between claim 83 and Kaster, claim 83 includes several references to elastic behavior of the claimed structure. For example, claim 83 specifies "a plurality of first members [that are] elastically deflectable [from extending substantially radially out from the annular structure to] substantially

parallel to a central longitudinal axis of the structure" In contrast to this, all significant deformations of Kaster's staple 12 are plastic (not elastic) deformations. That is why Kaster has to use all kinds of forming tools like 11 (FIG. 11) and 21 (e.g., FIGS. 18 and 19) to plastically reshape staple 12. No significant shape changes of Kaster's staple 12 are elastic. All such shape changes are plastic. In other words, once the shape of any portion of Kaster's staple 12 is changed, that staple portion holds its new shape. This is plastic deformation. In contrast, elastic deformation is only temporary. It lasts only as long as the deforming force continues to be applied. As soon as the deforming force is removed, the deformed structure elastically returns to its original shape. That is the way applicants' device works. It is not the way Kaster's staple works. Kaster therefore does not teach any of the elastic deflectability that applicants specify in claim 3.

For all of the foregoing reasons, claim 83 is not anticipated by Kaster. Claim 83 and its similarly rejected dependent claims 84, 85, and 87-90 are therefore allowable.

III. The Rejection Based on 35 U.S.C. § 103

Claim 86 has been rejected under 35 U.S.C. § 103 as obvious from Kaster. (Something else may have been intended for inclusion in the § 103 rejection, but the undersigned

attorney cannot be sure.) This rejection is also respectfully traversed.

Claim 86 is another claim that is dependent from claim 83. Applicants have shown above that Kaster teaches a plastically deformable staple. Nitinol is known for its elastic behavior. It would make no sense to attempt to make the Kaster staple from a highly elastic material. Kaster's entire disclosure relies on plastic deformation of staple 12 using various forming tools. Thus there is nothing about Kaster that would lead anyone to use nitinol in what Kaster teaches. There is therefore no basis for saying that claim 86 is obvious from Kaster. Claim 86 is accordingly allowable.

IV. Conclusion

The foregoing demonstrates that claims 83-90 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Robert R. Jackson", is written over a horizontal line.

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